REMARKS

Claims 12 to 22 are now pending.

Reconsideration is respectfully requested based on the following.

Claims 12 and 21 were rejected under 35 U.S.C. § 112, first paragraph, as to enablement. Claims 13 to 20, 22 were rejected as depending from either claim 12 or claim 21.

To make a § 112 rejection, the Office has the initial burden to establish a reasonable basis to question the enablement provided for the claim. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993) (examiner must provide a reasonable explanation as to why the scope of protection provided by a claim is not adequately enabled by the disclosure). According to *In re Bowen*, 492 F.2d 859, 862-63, 181 USPQ 48, 51 (CCPA 1974), the minimal requirement is for the examiner to give reasons for the uncertainty of the enablement. This standard is applicable even when there is no evidence in the record of operability without undue experimentation beyond the disclosed embodiments. See also *In re Brana*, 51 F.3d 1560, 1566, 34 USPQ2d 1436, 1441 (Fed. Cir. 1995) (citing *In re Bundy*, 642 F.2d 430, 433, 209 USPQ 48, 51 (CCPA 1981)) (discussed in MPEP § 2164.07 regarding the relationship of the enablement requirement to the utility requirement of 35 U.S.C. 101).

Still further, the rejection should focus on those factors, reasons, and evidence that led the examiner to conclude that the specification fails to teach how to make and use the claimed subject matter without undue experimentation, or that the scope of any enablement provided to one skilled in the art is not commensurate with the scope of protection sought by the claims. This can be done by making specific findings of fact, supported by the evidence, and then drawing conclusions based on these findings of fact. MPEP § 2164.04.

The Office has provided no support for the 35 U.S.C. § 112 rejection, beyond the conclusory assertion that "[t]here is no support in the specification for the amended/added limitation 'wherein the trigger signal will not cause the triggering of the occupant protection device unless the value in the z direction is below a threshold' in the claims". However, the specification contains numerous statements to support and enable this claim feature.

On page 2, lines 10 to 13, the specification specifically states that "[i]n this way, **a high acceleration value in the x/y plane**, for example which would result in a deployment, may be **corrected with a *likewise* occurring acceleration value in the z direction**, in order to avoid an erroneous deployment, e.g., when driving off-road." Further, at page 4, lines 23-

27, the specification specifically describes the following: "[b]ased on the z acceleration values in connection with the x and/or y acceleration values, trigger device 16 may now detect road bumps, such as a pothole, a curb, a wooden tie, a railroad track, or a ditch, possibly off-roading, and control triggering, i.e. trigger signal 18, of at least one occupant protection device 19 as a function thereof." Further, page 4, line 28 to page 5, line 2 specifically describes the following:

> According to algorithm 17, manipulation of the deployment decision may take place, for example, in such a way that **an x acceleration signal**, depending on the vehicle model, **is reduced at an appropriate level of the z acceleration value**. Only the peak levels of the acceleration signal (x direction) are then preferably reduced, or the entire signal level is reduced by a predefined amount. There is also the possibility of designing algorithm 17 in such a way that **the deployment threshold for generating trigger signal 18 is elevated as a function of the acceleration in the z direction**.

Further, page 5 lines 6-8 specifically describes the following: "in consideration of the z acceleration value, deployment of the occupant protection device(s) is stopped, even though the acceleration value in the x and/or y direction would trigger a deployment under normal circumstances." Other sections of the specification also describes the added claim feature.

Accordingly, the specification plainly describes the claimed subject matter and provides at least two such embodiments. Either of these embodiments (as well as others) could be implemented by a person of ordinary skill in the art without undue experimentation, therefore, the claimed subject matter satisfies the enablement requirement.

The Office has the burden of establishing a reasonable basis to question the enablement provided for the claimed subject matter, but has not done so. *In re Wright*, 999 F.2d 1557, 1562, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); MPEP 2164.04. The Office was required to "explain why the specification is not enabling, applying the factors set forth in *In re Wands*, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1998)", but has not done so. See MPEP 706.03(c) and MPEP 2164.01(a). As such, Applicant is unable to address any specific objections by the Office--since there are none.

Accordingly, it is respectfully requested that the rejections of claims 12 and 21 be withdrawn, as well as that of dependent claims 13 to 20 and 22.

Claims 12 to 22 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,167,335 "Ide" in view of U.S. Patent No. 6,137,335 "Khairallah".

In rejecting a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish prima facie obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. In re Fine, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. In re Vaeck, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Second, there must be a reasonable expectation of success. In re Merck & Co., Inc., 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Still further, the prior art must disclose or suggest each claim feature and it should also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (*See Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 934 (Fed. Cir. 1990), *cert. denied*, 111 S. Ct. 296 (1990); *In re Bond*, 910 F.2d 831, 834 (Fed. Cir. 1990)). As explained herein, it is respectfully submitted that the cited references, whether considered alone or in combination, do not disclose or suggest all of the features of the claims.

Claim 12, as presented, includes the feature of detecting an acceleration value in a z direction while simultaneously generating a corresponding second signal, in which the z direction is a vertical direction, and in which the occupant protection device will not trigger *unless the value in the z direction is below a threshold.* As the Office Action admits, the "Ide" reference does not refer to a z or vertical direction, but the Khairallah reference is asserted to overcome this deficiency in Ide. In fact, the Khairallah reference refers to a "controller [that] actuates the device (e.g., [an airbag]) to protect the occupant [] in response to the first metric[, acceleration in the x or y direction,] indicating a vehicle crash condition and the second metric[, acceleration in the z direction,] *exceeding* a predetermined threshold." (Khairallah, Abstract, lines 8-11 (emphasis added)). Thus, The Khairallah reference does not disclose, or suggest the feature of "triggering the occupant protection device . . . [only when] the value in the z direction is below a threshold", as provided for in the context of claim 12.

The Office also conclusorily asserts that: "Khairallah et al. also disclose set Z safe = low (See Fig. 3 #204) and set Z safe = high (See Fig. 3 #212) it is therefore obvious to one of

ordinary skill in the art to compare a threshold value wherein the trigger signal will not cause the triggering of the occupant protection device unless the value in the z direction is below a threshold." In fact, the reference states that at "step 204, a variable Z_SAFE, which represents a safing determination output, is set equal to LOW. A low value of the variable Z_SAFE indicates that the process has determined that a vehicle crash condition is not occurring. In contrast, the variable Z_SAFE is set HIGH upon a determination that the vehicle crash condition is occurring." It is abundantly clear that Z_SAFE is a binary logic gate variable that is either on (HIGH) or off (LOW). Even if Khairallah did disclose a low threshold and high threshold as the Office seems to be asserting, it still only states that "the second metric[, acceleration in the z direction,] *exceeding* a predetermined threshold"-- regardless of what level that threshold is set at. (Khairallah, Abstract, lines 10-11 (emphasis added)). Thus, The Khairallah reference does not disclose or suggest the feature of "triggering the occupant protection device . . . [only when] the value in the z direction is below a threshold", as provided for in the context of claim 12.

Claims 13 to 20 depend from claim 12 and are therefore allowable for at least the same reasons as claim 12.

Claims 21 and 22 includes features similar to those of claim 12 and is therefore allowable for essentially the same reasons as claim 12.

In summary, all of claims 12 to 22 are allowable.

CONCLUSION

In view of the foregoing, all of claims 12 to 22 are allowable. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

Respectfully submitted,
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